

Notice of Allowability

Application No.

09/750,116

Examiner

Rosemary E. Ashton

Applicant(s)

MAEDA ET AL.

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the papers filed 6 March 2006.
2. ☒ The allowed claim(s) is/are 1-23.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

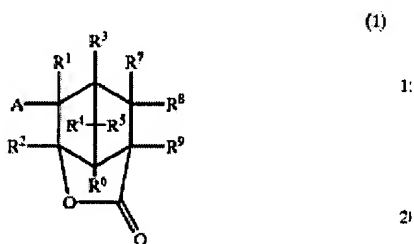
1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 3/6/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

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REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance: The prior art detailed in form PTO-892 of interest discloses a related monomer as set forth in the instant claims but assigns the (me)acrylate group to a specific site wherein in the instant application the (me)acrylate group is bound to one of seven carbon atoms. The prior art has attached to the same carbon atom as the (me)acrylate group or the carbon atom adjacent to the (me)acrylate group a C1 to C4 alkyl group (other than a t-butyl group). Assuming the site of the (me)acrylate group is the same as in the prior art the instant claims must have **both** the carbon atom attached to the (me)acrylate group **and** the carbon atom adjacent to the (me)acrylate group have hydrogen atoms attached to these sites.

Shown below is formula I taken from claim 1 of the prior art. R¹ and R² in the instant claims must both be hydrogen atoms, however, in the prior art, at least one of R¹ or R² is a C1 to C4 alkyl group (other than a t-butyl group),



wherein one of R¹ and R² represents an alkyl group, which has 1 to 4 carbon atoms and is other than a tert-butyl group, and the other represents a hydrogen atom or an alkyl group which has 1 to 4 carbon atoms and is other than a tert-butyl group; R³ to R⁹ each independently represent a hydrogen atom, a silyl group, a cyano group, a hydroxyl group, a halogen atom or a monovalent nonpolymerizable organic substituent group; and A represents a polymerizable group having a carbon-carbon double bond.

With respect to claims 15 and 17 of the instant application : The prior art detailed in form PTO-892 discloses a (me)acrylate monomer having a hydrocarbon group with 8 carbon atoms having an alicyclic lactone structure, Miwa et al., Okino et al., Kodama, Sato et al., Iwai et al. (11/27/01), Kinsho et al. (6/13/02), 3 Chen et al. patents all with (5/28/02), Uetani et al. (4/3/01), Watanabe (3/27/02), Nishi et al. (8/29/02), Takata et al. (3/26/02) and Hatakeyama et al. (2/15/01), all cited on applicant's IDS of

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3/6/06, read on claims 15 and 17 in that the lactones in the patents have 7-16 carbon atoms. The filing dates are in parentheses. The filing date of the prior art on PTO-892 is 8/16/00.

On 2/27/02 applicant submitted a certified translation of priority document JP 10-188853 having a date of 7/3/98 that overcomes any rejection over the prior art and the art listed above on applicant's IDS.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 571-272-1326. The examiner can normally be reached on Mon-Fri, 11:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rosemary E. Ashton
Primary Examiner
Art Unit 1752

June 22, 2006

**ROSEMARY ASHTON
PRIMARY EXAMINER**